

Response to Final Office Action
Serial No. 09/736,393
Page 2 of 7

REMARKS

This response is intended as a full and complete response to the final Office Action mailed July 28, 2004. In the Office Action, the Examiner notes that claims 1-9 and 21-28 are pending and stand rejected. By this response, all claims remain unamended, and arguments addressing the Examiner's rejections in each of these claims are provided below.

In view of the following discussion, Applicants submit that none of the claims pending in the application are anticipated under the provisions of 35 U.S.C. §102 or obvious under the provisions of 35 U.S.C. §103. Thus, Applicants believe that all of these claims are now in allowable form.

It is to be understood that Applicants, do not acquiesce to the Examiner's characterizations of the art of record or to Applicants' subject matter recited in the pending claims. Further, Applicants are not acquiescing to the Examiner's statements as to the applicability of the art of record to the pending claims by filing the instant response.

REJECTIONS

Rejection under 35 U.S.C. §102

The Examiner has rejected claims 1-2, 4-6, 8-9, 21-25 and 27-28 under 35 U.S.C. 102(e) as being anticipated by Shoff et al. (U.S. Patent 6,240,555, hereinafter "Shoff"). Applicants respectfully traverse the rejection.

"Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim" (Lindemann Maschinenfabrik GmbH v. American Holst & Derrick Co., 730 F.2d 1452, 221 U.S.P.Q. 481, 485 (Fed. Cir. 1984)(citing Connell v. Sears, Roebuck & Co., 722 F.2d 1542, 220 U.S.P.Q. 193 (Fed. Cir. 1983)) (emphasis added). Shoff does not teach a terminal processor for performing the functions as claimed and described via one way hyperlinking discussed in detail below. As such, Shoff fails to disclose each and every element of the claimed invention, as arranged in the claim. Specifically, Shoff presents, "the existence of a supplemental content data stream over the dedicated channel

254923_1.DOC

Response to Final Office Action
Serial No. 09/736,393
Page 3 of 7

indicates that the program being received on the selected channel is interactive compatible." In response to such existence, a "viewer computing unit" automatically accesses an EPG data structure to retrieve therefrom some means of identifying a target specification. Such means might comprise "a pointer to a memory location at the head end, or a pointer to a memory location on a locally running CD-ROM, or a hyperlink to a target resource located at an independent service provider." In the case of a hyperlink, a separate application denoted as a hyperlink browser is loaded onto the processor to access and render the resource reference by the hyperlink. This is entirely different than the subject invention.

Applicants' independent claims 1 and 21 recite:

"1. A system for broadcasting information over a television distribution network comprising:
a) a network headend for accessing information from one or more sources, and broadcasting said information;
b) a plurality of downstream channels interfaced to said headend for transmitting said information; and
c) a plurality of terminal devices for receiving said downstream channels, each said terminal device including:
1) a tuner for receiving and selecting said downstream channels; and
2) a terminal processor for receiving channel selection and information requests from a user, and instructing said tuner to select one of said downstream channels, said terminal processor including programming for receiving an information request from a user, and in response thereto, instructing said tuner to select, via one-way hyperlinking, one of said downstream channels on which said requested information is being transmitted from said headend.

21. A method for requesting and receiving information in a television distribution network comprising:
a) providing a network headend for accessing information from one or more sources, and broadcasting said information;
b) providing a plurality of downstream channels interfaced to said headend for transmitting said information;
c) providing a plurality of terminal devices interfaced to said downstream channels for receiving information on said channels, and formatting said information for display on a display device, each said terminal device including a tuner for receiving and selecting said downstream channels, and a terminal processor for receiving information requests from a user, and instructing said tuner to select, via one-way hyperlinking, one of said downstream channels;

Response to Final Office Action
Serial No. 09/736,393
Page 4 of 7

- d) receiving a request for information in said terminal device from an input device;
- e) identifying a one of said downstream channels on which said information is to be transmitted;
- f) causing said tuner to select, via one-way hyperlinking, said one of said downstream channels; and
- g) receiving said requested information with said terminal device."

The subject invention differs from the above-quoted portion of Shoff in that (1) the access of any hyperlinking is performed in response to a user input, rather than automatically. Moreover, the subject hyperlinking is presented to a user for such access, rather than being buried within a data structure of an electronic program guide. Additionally, (2) the selected resource access by the present invention comprises "one of said downstream channels on which said requested information is being transmitted from said head end." Thus, importantly, the requested information is being transmitted from a head end (rather than the independent service provider of Shoff). Accordingly, it is respectfully submitted that Shoff does not disclose each and every element of the claimed invention, arranged as in claims 1 and 21.

As such, Applicants submit that independent claims 1 and 21 are not anticipated and fully satisfy the requirements of 35 U.S.C. §102 and are patentable thereunder. Furthermore, claims 2, 4-6, 8-9, 22-25 and 27-28 provide additional limitations and are dependent directly or indirectly from independent claims 1 and 21. As such, and for at least the same reasons set forth above, Applicants submit that these dependent claims are not anticipated by the teachings of the prior art and fully satisfy the requirements of 35 U.S.C. §102. Therefore, Applicants respectfully request withdrawal of the rejection of claims 1-2, 5, 9, 21-22, 24 and 28.

Rejection under 35 U.S.C. §103

Claims 3, 7 and 26

The Examiner has rejected claims 3, 7 and 26 under 35 U.S.C. 103(a) as being unpatentable over Shoff in view of Eyer et al. (U.S. Patent No. 5,982,445, hereinafter "Eyer"). Applicants respectfully traverse the rejection.

Response to Final Office Action
Serial No. 09/736,393
Page 5 of 7

The test under 35 U.S.C. §103 is not whether an improvement or a use set forth in a patent would have been obvious or non-obvious; rather, the test is whether the claimed invention, considered as a whole, would have been obvious. Jones v. Hardy, 110 U.S.P.Q. 1021, 1024 (Fed. Cir. 1984) (emphasis added). Moreover, the invention as a whole is not restricted to the specific subject matter claimed, but also embraces its properties and the problem it solves. In re Wright, 6 U.S.P.Q. 2d 1959, 1961 (Fed. Cir. 1988) (emphasis added). The combination of Shoff and Eyer fails to teach or suggest Applicants' invention as a whole.

As indicated earlier under the arguments regarding anticipation, Shoff merely discloses the accessing of target specification information via a number of means (one such means including hyperlinking) for accessing supplemental content of a program on a separate channel. Nowhere in Shoff is there any teaching or suggestion of a terminal processor for receiving channel selection and information request from a user to select one of a number of downstream channels containing desired information wherein such user request instructions are executed via one way hyperlinking to select one of the downstream channels with the requested information from a headend.

Furthermore, Eyer does not bridge the substantial gap between Shoff and Applicants' invention. Specifically, Eyer is introduced to allegedly teach a first multiplexer 115 in FIG. 1 for multiplexing information streams on a downstream channel as it was indicated by the Examiner that Shoff fails to disclose such first multiplexer. The problem to be addressed in Eyer is a method to provide HTML-coded display data in a suitable manner and signal format for reproduction on a television. Doing so requires at least the existence of a multiplexer 115 by which programming services and information can be multiplexed with the HTML type data for transmission via antenna 120. This data is supplementary to the programming (Column 7, Lines 65-Column 8, Line 1) but in no way teaches, discloses or suggests for filling a user request for channel selection of a downstream channel from a headend via one-way hyperlinking. The HTML information is either textural or graphical displays that supplement the basic programming provided in Eyer. Accordingly, one skilled in the art would not be motivated to adapt the teachings of Eyer to the teachings of Shoff to arrive at Applicants' invention. Therefore, the combined references fail to embrace the problems

Response to Final Office Action
Serial No. 09/736,393
Page 6 of 7

that the Applicants' invention solves. Hence, the combination of Shoff and Eyer fails to teach or suggest Applicants' invention as a whole.

Even if the two references could somehow be operably combined (and Applicants submit that they cannot be operably combined), the combination would merely provide basic programming, supplemental information (some of which may be HTML) and a multiplexer for multiplexing both types of information together for transmission. Therefore, since the combination of Shoff and Eyer fails to teach or suggest the improvements and features of the subject invention, the combined references fail to teach or suggest Applicants' invention as a whole. As such, Applicants submit that claims 3, 7 and 26 are not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Therefore, Applicants respectfully request that the rejection be withdrawn.


CONCLUSION

Thus, Applicants submit that none of the claims, presently in the application, is anticipated or obvious under the respective provisions of 35 U.S.C. §102 or §103. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Eamon J. Wall, Esq. and Joseph Pagnotta, Agent at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

Dated: Oct 12, 2004


Joseph Pagnotta, Agent
Registration No. 39,322

Response to Final Office Action
Serial No. 09/736,393
Page 7 of 7

MOSER, PATTERSON & SHERIDAN, LLP
595 Shrewsbury Avenue, Suite 100
Shrewsbury, New Jersey 07702
Telephone: 732-530-9404
Facsimile: 732-530-9808

254923_1.DOC